



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

DAVID H. JUDSON
15455 DALLAS PARKWAY
SUITE 600
ADDISON, TX 75001

COPY MAILED

DEC 16 2004

OFFICE OF PETITIONS

In re Application of :
Pratyush Moghe :
Application No. 10/780,252 : **DECISION ON PETITION**
Filed: February 17, 2004 :
Attorney Docket No. Tizer - 001 :

This is a decision on the PETITION UNDER 37 C.F.R. 1.53(e) TO ACCORD ORIGINAL FILING DATE, filed October 21, 2004. Applicant requests that the above-identified nonprovisional application be accorded its original filing date of February 17, 2004, and that the petition fee of \$130 be refunded.

The petition is **GRANTED**.

The request for refund is **GRANTED**.

Application papers in the above-identified nonprovisional application were deposited on February 17, 2004. However, on August 10, 2004, the Initial Patent Examination Division mailed applicants a "Notice of Incomplete Nonprovisional Application," stating that the application papers deposited February 17, 2004 had not been accorded a filing date because the application was deposited without drawings. (In addition, the Notice required the filing of a substitute specification.)

In response, applicant filed the instant petition. Petitioner states that applicant filed the application *pro se* and was unfamiliar with the requirement that drawings cannot be filed as embedded objects in a specification. (Petitioner has submitted a substitute specification to remove the embedded drawings.) Petitioner states, nevertheless, drawings were not necessary for the understanding of the subject matter sought to be patented. Specifically, petitioner states that the original application contained one or more method claims and, therefore, the application is an application for which drawings are not necessary under 35 U.S.C. 113.

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 111(a)(4) provides that:

The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

However, as stated in MPEP 601.01(f)

It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

In regards to withdrawing the Notice, MPEP § 601.01(f) also states that:

a nonprovisional application having at least one claim ..., directed to subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description.

And, MPEP § 601.01(g) further provides that:

If the application is filed without all of the drawing figure(s) referred to in the specification, ..., OIPE will mail a "Notice of Omitted Item(s)" indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of the drawings described in the specification.

DISCUSSION

A review of the application confirms that as filed it contained at least one method claim. Pursuant to § 601.01(f), a drawing is not considered essential for a filing date. Thus, the application is entitled to a filing date without drawings present in the application.

However, as the specification in the instant nonprovisional application contained reference to drawing figures 1 through 7 (Brief Description of Drawings, p. 4 of Specification), mailing of a Notice requiring submission of those drawings was appropriate. The Office should have mailed a "Notice of Omitted Items" rather than a "Notice of Incomplete Nonprovisional Application." To the extent that the Notice stated that the instant application is not entitled to a filing date, the "Notice of Incomplete Nonprovisional Application" mailed August 10, 2004, was mailed in error and is hereby withdrawn.

In view thereof, the application as originally deposited without drawings is entitled to a filing date of February 17, 2004.


Given the basis for granting the petition, the petition fee is being refunded by Treasury Check under separate cover.

Receipt of the power of attorney and change of address filed with the petition is acknowledged and made of record.

CONCLUSION

The Office of Initial Patent Examination (OIPE) has been advised of this decision. Pursuant to this decision, the application has been referred to OIPE for further processing with a filing date of February 17, 2004 and for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing.

Telephone inquiries specific to this decision may be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions